

REMARKS

Claims 30-32 are pending for prosecution in the present patent application.

The present application was remanded to the Examiner following a Decision on Appeal on August 22, 2002. In the present non-final Office Action of January 28, 2003, the Examiner rejected claims 30-32 under 35 U.S.C. §102(b) as being anticipated U.S. Patent No. 4,662,803 to Arnold (hereinafter "the Arnold patent"). In addition, the Examiner has also rejected claims 30-32 under 35 U.S.C. §112, ¶1 and objected to the drawings. In response, the Applicant has amended the specification, enclosed formal drawings and provides the remarks below.

With respect to paragraph 3 of the Office Action, the Applicant has enclosed formal drawings (FIGS. 1-10) to replace the current informal drawings. Applicant submits that new FIGS. 8-10 now clearly show the helical flutes extending longitudinally along the first and second cutting portion. Applicant further submits that no new matter was entered in the enclosed formal drawings. Therefore, Applicant believes that the drawings now clearly show every feature of the invention, as specified in claims 30-32, and respectfully requests that the Examiner now withdraws the present objections.

With respect to paragraph 4 of the Office Action, the Applicant has amended the specification, as provided above, to address the Examiner's rejection under 35 U.S.C. §112, ¶1. The specification has been amended to reasonably convey to one skilled in the relevant art the subject matter of the claims. Specifically, identifiers 154 and 156 were amended to identify a "first cutting portion" and "a second cutting portion," respectively, in order to use language consistent with that found in claims 30-32. The following sentence has also been added:

Helical cutting flutes 160 (as shown in FIGS. 9 and 10)
extend longitudinally along both the first cutting portion

154 and the second cutting portion 156 of the rotary cutting tool 152.

Applicant submits that the amended portions do not contain any new matter. Rather, matter that was already present in the claims and drawings has simply been clarified. Applicant now believes that the subject matter of the claims is now clearly described in the specification and respectfully requests that the Examiner withdraws the present rejection.

With respect to paragraph 7 of the Office Action, the Applicant respectfully disagrees with the Examiner's rejection of claims 30-32 under 35 U.S.C. §102(b) as being anticipated by the Arnold patent. The Examiner has adopted a new interpretation of the Arnold patent. With respect to claim 30, the Examiner has interpreted Arnold as disclosing "a first cutting portion (18, near element 44) defining a first outer diameter and second cutting portion (12) defining a second outer diameter..." (See Office Action, p. 3, ¶3). The Examiner further notes that:

...Arnold discloses a tapered section (the partial portion of 18 between the first cutting portion (18, near element 44) and the second cutting portion 12); and the first cutting portion (18) and the second cutting portion (12) being generally cylindrical.

(See Office Action, p. 3, ¶4). The applicant respectfully disagrees and traverses the Examiner's rejection below.

With respect to Examiner's rejection of claim 30, the claim language clearly requires that "a first cutting portion defining a first outer diameter." The Encarta World English Dictionary, © Bloomsbury Publishing Plc 1999, defines the word "portion" as "2. FRACTION a part or section of a larger whole." Therefore, the claim clearly requires that the first cutting *portion* – or a part or section of a larger whole – define a first outer diameter.

Conversely, the Arnold patent discloses that:

[t]he reamer 10 comprises a *cylindrical* forward guide portion or core 12 having a first end 14 coupled to a first end 16 of a *conical* rear portion or core 18, such that their longitudinal axes 20 and 21, respectively, are coincident. The rear portion 18 *tapers outwardly* to a second end 22...

(See the Arnold patent, col. 2, lines 56-61). Accordingly, the rear portion (18), which encompasses the "first cutting portion" defined by the Examiner (i.e., "18, near element 44"), of the reamer in the Arnold patent is not "generally

cylindrical". Rather, as is explicitly stated in the specification, the rear portion (18) is conical in shape and tapers outwardly to the second end (22). Because the rear portion 18 is conical in shape and tapers outwardly, there are, by definition, no part or section where the diameter is the same throughout. Rather, as one progresses along the axis of the rear portion toward the second end 22 of the Arnold reamer, the diameter of the core (18) continually changes, becoming larger and larger. Therefore, the conical rear portion (18) of the Arnold patent, or any portion thereof, can not define a first cutting *portion* that defines an outer diameter, let alone have a generally cylindrical shape.

Accordingly, the applicant respectfully submits that the Arnold patent does not anticipate claim 30 of the present patent application because it does not disclose a first cutting *portion* defining an outer diameter as required by claim 30 of the present application. The applicant respectfully submits that the Examiner's rejection in the present matter is, therefore, improper and requests that the present rejection of claim 30 be withdrawn.

Additionally, Claims 31 and 32 are both dependent on claim 30. Applicant submits that these claims are patentably distinguished from the Arnold patent in the same way as claim 30, as well as by virtue of the additional limitations clearly set forth therein. Applicant respectfully requests that the present rejections be withdrawn with respect to these claims, as well.

Applicant believes that no fees are due at this time; however, please charge any deficiencies to our Deposit Account No. 13-0235. Applicant also respectfully requests that the Examiner contact the Applicant's representative at the phone number listed below should the Examiner have any questions regarding the present Response.

Respectfully submitted,

By



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